

Appl. No. 09/806,457

REMARKS

Claims 1, 7-16, 23-25, 27-29, and 36-45 are now present in this application.

The specification and claims 1, 7, 10, 28, 29 and 36 have been amended, claims 2-6, 17-22, 26, and 30-35 have been cancelled without prejudice to or disclaimer of the subject matter contained therein, and claims 38-45 have been presented. Claims 1 and 29 are independent. Reconsideration of the application, as amended, is respectfully requested.

Objection to the Drawings

The drawings stand objected to under 37 CFR 1.437 and PCT Rule 11.13(1), for contain certain reference numerals which are not discussed in the specification. In view of the foregoing amendments, it is noted that reference numerals 2, 5 and 7 have been added to the specification. Also, attached hereto is a corrected Fig. 1, in which reference numeral "8" has been removed. Accordingly, it is believed that this drawing objection has been overcome. Reconsideration and withdrawal of any objection to the drawings are respectfully requested.

Objection to the Claims

Claims 1, 5, 6, 10, 29, 34 and 36 stand objected to for certain informalities. In view of the foregoing amendments, it is

Appl. No. 09/806,457

respectfully submitted that these informalities have been addressed. Reconsideration and withdrawal of any objection to the claims are respectfully requested.

35 U.S.C. § 112, Second Paragraph Rejection

Claims 33 and 34 stand rejected under 35 U.S.C. § 112, second paragraph. This rejection is respectfully traversed.

As the Examiner will note, claims 33 and 34 have been canceled without prejudice to or disclaimer of the subject matter contained therein. Accordingly, the rejection under 35 U.S.C. § 112, second paragraph has been rendered moot.

35 U.S.C. § 112, First Paragraph Rejection

Claims 1-37 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In addition, claims 6 and 34 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. These rejections are respectfully traversed.

With regard to claims 2-6, 17-22, 26 and 30-35, as the Examiner will note, these claims have been canceled without prejudice to or disclaimer of the subject matter contained therein. Accordingly, the Examiner's rejections under 35 U.S.C. § 112, first paragraph, have been rendered moot with regard to these claims.

Appl. No. 09/806,457

With regard to independent claims 1 and 29, these claims have been amended to delete the recitations "at least a first light beam" and "at least a first light source." Accordingly, these claims comply with the written description requirement.

In view of the above amendments and remarks, Applicants submit that claims 1, 7-16, 23-25, 27-29 and 36-45 comply with the enablement and written description requirements. Accordingly, reconsideration and withdrawal of the 35 U.S.C. § 112, first paragraph rejections are respectfully requested.

35 U.S.C. § 103 Rejections

Claims 1-3, 7-14, 17, 18, 23-31 and 35-37 stand rejected under 35 U.S.C. § 103 as being unpatentable over GORDON, U.S. Patent 5,892,577, in view of EKINS et al., "Multianalyte microspot immunoassay-microanalytical 'compact disk' of the future," Clinical Chemistry, Vol. 37, No. 11 (1991), pp. 1955-1967. This rejection is respectfully traversed.

Claims 4, 5, 32 and 33 stand rejected under 35 U.S.C. § 103 as being unpatentable over GORDON in view of EKINS et al., and further in view of SHIH et al., U.S. Patent 6,188,132. This rejection is respectfully traversed.

Claims 6 and 34 stand rejected under 35 U.S.C. § 103 as being unpatentable over GORDON in view of EKINS et al., and further in

Appl. No. 09/806,457

view of CHANCE et al., U.S. Patent 3,963,351. This rejection is respectfully traversed.

Claims 15 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over GORDON in view of EKINS et al., and further in view of DEMERS, International Publication No. WO 98/12559. This rejection is respectfully traversed.

Claims 19-22 stand rejected under 35 U.S.C. § 103 as being unpatentable over GORDON in view of EKINS et al., and further in view of PRASAD et al., U.S. Patent 5,912,257, and GIBBONS et al., U.S. Patent 5,846,452. This rejection is respectfully traversed.

At the outset, it is respectfully pointed out that claims 2-6, 17-22, 26 and 30-35 have been canceled without prejudice to or disclaimer of the subject matter contained therein. Accordingly, the Examiner's rejections under 35 U.S.C. §§ 102 and 103 have been rendered moot with regard to these claims.

With regard to independent claims 1 and 29 of the present invention, these claims have been amended to recite that the frame with the specimen is moved during scanning, whereas the scanning system comprising detector and light source is kept in a fixed position. It is furthermore emphasized that the detector detects properties of marked objects in the specimen.

Support for this amendment can be seen in claim 7 as originally filed. Support for this amendment can also be found on page 4, lines 26-35 of the originally filed specification, which

Appl. No. 09/806,457

recites that "the scanning means may be adapted to scan the light beam across the specimen along the non-linear curve" and page 5, lines 1-5, which recites that "scanning means may also comprise deflecting means that may comprise a servo motor or a stepper motor connected to the member holding the specimen and thereby adapted to scan the first light beam along a radius of the circular movement of the disc holding the specimen". It is therefore respectfully submitted that it is clear that the scanning means are connected to the member holding the specimen so that the member is moved in relation to the light beam providing a scanning function. Further support for this feature can also be found in the description of the drawings on page 16, lines 17-19 and 31-33, for example.

GORDON discloses a system according to a typical CD player wherein the disc is rotated while the detector is moved across the disc (see page 3, lines 10-13 and page 15, lines 20-21, for example).

GORDON fails to disclose displacing the member or disc along a radius of the circular movement of the member (disc), and, thus, keeping the detection system fixed during scanning. In view of this, GORDON fails to disclose "means for displacing the member along a radius of the circular movement of the member, so as to detect the property of the marked objects in the entire specimen" as recited in independent claim 1 of the present invention. In addition, GORDON fails to disclose "scanning the specimen in

Appl. No. 09/806,457

relation to a detector along a non-linear curve by rotating the member holding the specimen and displacing the member along a radius of the circular movement of the member" as recited in independent claim 29 of the present invention. Thus, independent claims 1 and 29 of the present application are neither taught nor suggested by GORDON.

With regard to EKINS et al., the Examiner has noted that "the apparatus of GORDON lacks an explicit example of two or more fluorescent markers" and that EKINS et al. teaches "that 'ratiometric' immunoassay involves measuring fluorescents emitted by two labels using laser scanning techniques closely analogous to those used in compact disk techniques." In this regard, it is noted that the limitations of staining the object(s) with fluorescent markers have been removed from both independent claims 1 and 29. Accordingly, the reference to EKINS et al. is no longer relevant to independent claims 1 and 29 of the present application.

With regard to dependent claims 7-16, 23-25, 27, 28, 36 and 37, Applicant respectfully submits that these claims are allowable due to their respective dependence on independent claims 1 and 29, as well as due to the additional recitations in these claims.

The secondary references utilized by the Examiner fail to overcome the deficiencies of GORDON.

Accordingly, it is respectfully submitted that the claims of the present application are neither taught nor suggested by the

Appl. No. 09/806,457

prior art utilized by the Examiner. Reconsideration and withdrawal of the 35 U.S.C. § 103 rejections are respectfully requested.

Favorable reconsideration and an early Notice of Allowance are earnestly solicited.

Because the additional prior art cited by the Examiner has been included merely to show the state of the prior art and has not been utilized to reject the claims, no further comments concerning these documents are considered necessary at this time.

In the event that any outstanding matters remain in this application, the Examiner is invited to contact the undersigned at (703) 205-8000 in the Washington, D.C. area.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), the Applicants respectfully petition for a three (3) month extension of time for filing a response in connection with the present application and the required fee of \$475.00 is attached herewith.

Appl. No. 09/806,457

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By Paul C. Jarr
for Joe McKinney Muncy, #32,334
P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000 #43,368

KM/asc/slb
0459-0577P

Attachment: Corrected Formal Drawing

(Rev. 02/12/2004)

Certificate of Transmission
I hereby Certify that this correspondence is being
facsimile transmitted to the Patent and
Trademark Office:
On 4-06-04
Sarah L. Beatty
Signature
SARAH L. BEATTY
Typed or printed name of person signing certificate